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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,585	04/14/2004	James Kam Fu Kong	V9661.0049	6212

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EXAMINER
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JACKSON, BRANDON LEE

ART UNIT	PAPER NUMBER
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3772

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06/25/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/823,585	<b>Applicant(s)</b> FU KONG ET AL.	
	<b>Examiner</b> BRANDON JACKSON	<b>Art Unit</b> 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to amendments/arguments filed 5/29/2008. Currently, claims 1-20 are pending in the instant application.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/29/2008 has been entered.

#### ***Response to Arguments***

Applicant's arguments filed 5/29/2008 have been fully considered but they are not persuasive. Applicant argues the Kurland lateralization member (18) is rigid and not capable of rotation to affect the angular orientation of the lateralization member, adjusting the lateralization effect. However, the Kurland lateralization member (18) is mounted upon a threaded support member (32). The lateralization member (18) is capable of rotating about the support member (32, 33, 34) because the support member (32, 33, 34) is threaded. Therefore, when the Kurland lateralization device is modified with the eccentric lateralization member of Kostich, the eccentric nature of the Kurland/Kostich lateralization member would cause a change in the angular orientation

of the lateralization member when rotated about the threaded support post. Rotating the lateralization member of Kurland/Kostich would allow the user to adjust lateralization member, which in turn would alter the lateralization effect.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-12, 14, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kurland (US Patent 4,653,482). Kurland discloses a lateralization device (fig. 1) comprising a supporting member (32, 33, 34) adapted to be supported in a fixed position, a lateralization member (18, 31) mounted onto the supporting member (32, 33, 34) and expanding laterally therefrom to provide a lateralization effect to a user's body portion, wherein the lateralization effect varies in different lateral directions via moving the lateralization device (fig. 1) along the lateral slot (19). The supporting member (32, 33, 34) comprises a post member (32), wherein the post member (32) comprises a substantially cylindrical outer wall. The post member (32) comprises a plurality of interference fittings (fig. 4) on the outer wall for engaging with complementary interference fittings (fig. 4) formed on an inner wall of the lateralization member (18, 31). The lateralization member (18, 31) is formed of a material that can resist pressure exerted thereon and maintain its initial shape during moral use. The lateralization

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member (18, 31) comprises a substantially cylindrical member (31) with a recessed portion (fig. 4) formed by an inner wall, wherein the cylindrical member (31) has a substantially circular cross-section. The lateralization member (18, 31) comprises a padding member (col. 2, lines 41-42) that wraps around the lateralization member (18, 31). The lateralization member (18, 31) can rotate relative to the supporting member (32, 33, 34). The lateralization member (18, 31) is fully capable of being used to provide lateralization to a user's hip joint during a hip arthroscopy. The supporting member (32, 33, 34) is adapted to be mounted onto a fracture table.

With respect to claims 19-20, Kurland discloses all the structural elements of the claimed invention; therefore, the method steps would have resulted from the use of the Kurland device.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 13, and 16-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US Patent 4,653,482) in view of Kostich (US Patent 5,623,949). Kurland substantially discloses the claimed invention; see rejections to 1-7, 9-12, and 14 above. Kurland fails to disclose the recessed portion is located in an eccentric position on the cylindrical member. However, Kostich teaches a positioning device (110) comprising eccentric cylindrical members (144). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the lateralization member of Kurland to have the shape, as taught by Kostich, in order to better receive body parts and provide the user with more comfort. The eccentric nature of the Kurland/Kostich lateralization member would cause a change in the angular orientation of the lateralization member when rotated about the threaded support post. Rotating the lateralization member of Kurland/Kostich would allow the user to adjust lateralization member, which in turn would alter the lateralization effect.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurland (US Patent 4,653,482) in view of Spetzler et al. (US Patent 6,805,453). Kurland substantially discloses the claimed invention; see rejection to claim 1 above. Spetzler teaches a medical device (100) comprising a drape (110) to cover the device (100). Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to modify the Miller device to have a drape covering the lateralization device, as taught by Spetzler, in order to keep the device sterile after usage.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDON JACKSON whose telephone number is (571)272-3414. The examiner can normally be reached on Monday - Friday 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571)272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brandon Jackson/  
Examiner, Art Unit 3772

BLJ

/Patricia Bianco/  
Supervisory Patent Examiner, Art Unit 3772